

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES K. LEE and FREDERICK J. JEFFERS

Appeal No. 1998-0866
Application No. 08/698,707¹

ON BRIEF

Before HARKCOM, Vice Chief Administrative Patent Judge, ABRAMS
and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-5, which are all of the claims pending in this application.

¹ Application for patent filed August 16, 1996.

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BACKGROUND

The appellants' invention relates to a camera with a magnetic roller recorder for repetitively recording owner-personalization information along a magnetic track on the filmstrip (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Brock et al. (Brock)	5,519,464	May 21, 1996
Goto et al. (Goto)	5,543,872	Aug. 6, 1996
Swanson et al. (Swanson)	5,572,267	Nov. 5, 1996
	(filed Aug. 23, 1994)	

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Swanson in view of either Brock or Goto.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed October 1, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 12, filed August 18, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We cannot sustain the examiner's rejection of appellants' claims 1-5 under 35 U.S.C. § 103.

At the outset, we particularly note that independent claim 1 is drawn to a camera and a recording device.

Claim 1 recites,

1. A camera comprising an information-bearing medium movable to record non-varying information on a filmstrip, is characterized in that: said information-bearing medium is a magnetic roller recorder having a roller periphery on which is magnetically stored the non-varying information; and means rotationally supports said roller recorder in place for stationary rolling contact of said roller periphery with a magnetic track on a filmstrip as the filmstrip is advanced, whereby the non-varying information can be repetitively recorded along the magnetic track on the filmstrip.

The examiner's rejection of claim 1 points out that "[t]he difference between Swanson et al. and the claimed invention is the magnetic roller recorder is rotatably mounted

on the camera body" (final, page 2). Brock and Goto are cited for their teaching of employing a plate at the back of a camera to support the magnetic recorder and the examiner concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Swanson et al. by rotatably mounting the magnetic roller recorder on the camera body by having 'a plate which rotationally supports said magnetic roller recorder in place and is constructed to be fitted to said rear housing portion to light-tightly seal said rear opening'" (final, pages 2-3).

Appellants urge that "Brock et al. and Goto et al. are quite different than Swanson et al." in that "Brock et al. and Goto et al. simply show fixed magnetic heads 60 and 8 in cameras... [n]o information is permanently stored on the magnetic heads, and the magnetic heads are stationary" whereas "[i]n Swanson et al. , **non-varying** information is **permanently stored** on the rotatable roller wheel... intended for a **single** brief recording of the information only at **one** location on the MOF" (brief, page 5). Appellants conclude that "one of ordinary skill in the art would not necessarily be motivated

to combine the three references for the purpose of recording information on the MOF (much less be motivated to arrive at the claimed invention), because of the diverse approaches they teach" (brief, page 5).

In response, the examiner urges that "[s]uch argument should not be deemed persuasive because 'the diverse approaches they teach' do not lead the ordinary artisan away from modifying Swanson et al. in the manner set forth by the Examiner" (answer, page 5).

We note that in the SUMMARY OF THE INVENTION section Swanson teaches that it is advantageous to provide an unpowered recording medium external to the camera (col. 2, lines 1-21). Swanson notes that "there is a need for a system that permits information to be recorded into the MOF layer of photographic film without requiting (sic) specially-equipped cameras and without requiring entry of information by the photographer" (col. 1, lines 59-62). Thus, Swanson recognizes that known internal camera recording devices have some disadvantages over a recording device external to the camera.

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We find that modification of the Swanson device to provide an internal recording device as suggested by Brock or Goto teaches away from the objective disclosed in Swanson and would not have been an obvious modification at the time the invention was made to a person having ordinary skill in the art.

Accordingly, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

NEW GROUNDS OF REJECTION

Under the authority of 37 CFR § 1.196(b), this panel of the board introduces the following new grounds of rejection as to claims 1, 4 and 5.

Claims 1, 4 and 5 are rejected under 35 U.S.C. § 103 as being unpatentable over Brock in view of Swanson.

We note that both Brock and Swanson teach recording magnetic information on a magnetic track on film in a camera.

Each discuss the various types of information that may be recorded, e.g. the name of the owner of the camera, the date and/or location of the picture being taken, the camera settings (Swanson, col. 1, lines 11-37, and Brock, col. 1, lines 37-50) and the type of recording device suitable to

record the desired information. Brock teaches a magnetic head recording device 60 (Fig. 1) which is mounted internal to the camera along the magnetic track on the filmstrip. Brock teaches the elements of appellants claim 1 except for the specific type of recording device. Swanson discloses recording onto the magnetic strip of film with different types of recording devices (linear array 18 of Fig. 1 or magnetic roller 106 of Fig. 3). Other types of recording devices are discussed, for example "[t]o increase the amount of data that can be recorded in a fixed length of magnetic media, such as a frame of a photographic filmstrip, multiple roller wheels may be provided" (col. 5, lines 23-26). We find that it would be obvious to modify Brock by providing the roller type of recording device of Swanson in place of the magnetic head shown by Brock. The choice of the type of recording device is an obvious choice as taught by Swanson, and is dependent on factors such as the amount and type of information to be recorded. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Brock's camera and recording mechanism by

providing a magnetic roller as the recording mechanism as taught by Swanson.

We reject appellants' notion that the references are not combinable because "of the diverse approaches they teach" (brief, page 5). Rather, we observe that the references simply teach different ways of recording different types of desired information on the magnetic strip portion of film. In the present instance appellants indicate a desire to provide the same information (e.g. the owner's name and address) repeatedly for each frame of the film (specification, pages 2-3). Swanson teaches that his disclosed roller retains magnetic field strength so that it is capable of "multiple insertions" (col. 5, line 63) and "[t]he present invention should therefore not be seen as limited to the particular embodiment described herein..." (col. 6, lines 20-22).

Likewise, we reject appellants' suggestion that "in Swanson et al. the roller wheel 106 appears to be at least as wide as the filmstrip 14" such that "[i]ts use in Brock et al. and Goto et al. would scratch the film exposures" and "[t]hus, Swanson et al. would discourage one skilled in the art to make the combination with Brock et al. and Goto et al." (brief,

page 5). Clearly each of Swanson and Brock teach the recording device is to record on the magnetic strip only and to avoid contamination of the picture portion. We find that at the time the invention was made a person having ordinary skill in the art combining the teachings of Brock and Swanson would provide that the roller be limited to printing on the magnetic strip without contaminating the picture portion of the film.

Appellants' claims 4 and 5 further limit claim 1 by providing that the information magnetically stored on said roller periphery "constitutes a series of continuously-repeating complete identical messages" (claim 4) and "are sufficiently short to ensure that at least one of the identical messages will be recorded on the magnetic track for each exposed frame of the filmstrip" (claim 5). Swanson discloses that the roller wheel depositing the information onto the magnetized strip "can make one complete revolution within the space of a single frame" (col. 5, lines 15-16) and "the pattern can be repeated around the roller wheel, providing redundant patterns, if desired for error checking or other safeguard against slippage" (col. 5, lines 19-22). The

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limitations of claims 4 and 5 are taught by, or obvious from, Swanson's disclosure of providing repeated messages and a complete message for each frame.

In summary, this panel of the board has reversed the rejection of claims 1-5 under 35 U.S.C. § 103 as being unpatentable over Swanson in view of either Brock or Goto.

Additionally, we have introduced a new ground of rejection for claims 1 and 4-5.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR § 1.197). Should appellants elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.196(a).

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CONCLUSION

The decision of the examiner is reversed.

REVERSED 37 CFR § 1.196(b)

GARY V. HARKCOM)	
Vice Chief Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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RICHARD B. LAZARUS)	
Administrative Patent Judge)	

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APJ LAZARUS

APJ ABRAMS

APJ HARKCOM

DECISION: **AFFIRMED**

Prepared By: RBL

DRAFT TYPED: 26 Jun 01

FINAL TYPED: